

REMARKS

Favorable reconsideration of this application in light of the following discussion is respectfully requested.

Claims 1-12 and 19-20 are presently active in this case. Claims 1-3, 6, 9-10, and 19 are amended without introducing any new matter; and Claim 21 is cancelled without prejudice or disclaimer.

The pending Office Action rejected Claims 1-12 and 19-21 under 35 U.S.C. § 103(a) as being unpatentable over *Ito et al.* (U.S. Patent No. 5,671,354, hereinafter "*Ito*") and *Shiotsu et al.* (U.S. Patent No. 6,993,358, hereinafter "*Shiotsu*").

First, Applicants wish to thank Examiner Mirza for the courtesy of an interview granted to Applicants' representative on May 2, 2007, at which time the outstanding issues in this case were discussed. Arguments and claim changes similar to the ones developed herein were presented, and the amendment is filed together with a Request for Continued Examination (RCE). The Examiner indicated that he would reconsider the outstanding grounds for rejection upon formal submission of a response.

Claim 1 is amended to delete the conditional claim language "when requested by a user" and to direct the invention to wireless terminal devices. In addition, the features regarding the communication server machine are clarified to recite:

a communication server machine connected to the network and operable to manage, based on the identification numbers, **user information for users of each client terminal device indicating at least conditions under which each client terminal device is connected to the network**, the communication server machine being further operable (i) **to select a communication application suitable for both a first client terminal device and a second client terminal device based on the user information** for a user of the first client terminal device and a user of the second

client terminal device, after at least one of the users request communication, and (ii) to make a connection for communication between the first client terminal device and the second client terminal device,

wherein the **conditions include an available transmission bit rate of each client terminal device**, and a type of peripheral device associated with each client terminal device.

Claim 1, emphasis added, portions omitted. Claim 1 is also amended to correct minor formalities. The remaining independent Claims 2-3, 6, 9-10, and 19 are amended in a similar way. The changes find non-limiting support in Applicants' specification as originally filed, for example from p. 6, ¶ 30, to p. 8, ¶ 45.

In response to the rejection under 35 U.S.C. § 103(a), Applicants respectfully traverse the rejection, and request reconsideration thereof, as next discussed.

Briefly recapitulating, Claim 1 relates to a communication system. The communication system includes, *inter alia*, wireless client terminal devices connected to a predetermined network, each client terminal device being assigned a unique identification number, a communication server machine connected to the network and operable to manage, based on the identification numbers, **user information for users of each client terminal device indicating at least conditions under which each client terminal device is connected to the network**, the communication server machine being further operable (i) to **select a communication application suitable for both a first client terminal device and a second client terminal device based on the user information** for a user of the first client terminal device and a user of the second client terminal device, after at least one of the users request communication, wherein the **conditions include an available transmission bit rate of each**

client terminal device, and a type of peripheral device associated with each client terminal device.

First, Applicants respectfully submit that neither *Ito* nor *Shiotsu*, taken individually or in any proper combination, teaches a feature regarding an available transmission bit rate, as required by Applicants' independent Claim 1. As confirmed by the pending Office Action, the *Ito* reference fails to teach any feature regarding a transmission band (Office Action at page 3, lines 1-3). The Office Action rejects the above features based on the proposition that *Shiotsu* describes the above features,¹ and that it would have been obvious to modify *Ito* by importing these features from *Shiotsu* to arrive at Applicants' Claim 1 features. Applicants respectfully submit, however, that *Shiotsu* fails to teach the above feature related to the conditions including a transmission band, as next discussed.

The pending Office Action relies on *Shiotsu*'s disclosure at col. 7, ll. 20-30. This passage of *Shiotsu* recites "protocols by which communication is to be done." Applicants submit that the selection of a protocol is not the indication of an **available transmission bit rate of each client terminal device**. In addition, *Shiotsu* explains in this passage that the user "modifies ... the transmission power default values ... by entering the higher transmission power level H_i or $H_{i,j}$ and the lower transmission power level $L_{i,j}$ for each of the entered application programs." Reading *Shiotsu*, a person of ordinary skill in the art would understand that a user determining transmission power levels for different programs **is not** user information including an **available transmission bit rate of each client terminal device**, as required by Claim 1.

As further required by Applicants' Claim 1, a communication application is selected that is suitable for both

¹ See the pending Office Action at page 3, second paragraph.

a first client terminal device and a second client terminal device **based on the user information** for a user of the first client terminal device and a user of the second client terminal device. The cited passages of *Shiotsu* also fail to teach such a feature. Accordingly, both *Ito* and *Shiotsu* fail to teach every feature of the independent claims.

Second, Applicants respectfully traverse the obviousness-type rejection based on *Ito* and *Shiotsu* because there is insufficient evidence for a motivation to modify *Ito*'s method for authenticating users accessing a network by incorporating *Shiotsu*'s setting of transmission power level, for the following reasons.

The outstanding Office Action states that the proposed modification would have been obvious "that The [sic] user may select a setting mode display on the personal computer 1 and enter titles of available information processing devices data, such as types of the information processing devices with which the personal computer is to communicate or protocol by which communication is to be done. Then, he or she modifies, through a keyboard, the transmission power default values."²

The Office Action seems to use improper hindsight reconstruction by setting forth a motivation to combine *Ito* with *Shiotsu*, without providing the required evidence. The M.P.E.P. § 2141 states as one of the tenets of patent law applying to 35 U.S.C. § 103, that "[t]he references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention."

The record clearly fails to provide the **required evidence** for a motivation for a person of ordinary skill in the art to perform such modification of *Ito*. Assuming that *Shiotsu* provides a reason for using "titles of available information

² See outstanding Office Action at page 3, paragraph 2.

processing device data" in a system for **adjusting transmission power** to avoid inter-channel and co-channel interference,³ *Shiotsu* fails to suggest why a person of ordinary skill in the art would be motivated to incorporate such a feature in an **authentication method** for client terminals accessing a server, such as the one disclosed in *Ito*. In particular, *Shiotsu* uses the transmission power levels and available information processing devices in order to increase reliability of communications and to reduce interference between devices.⁴ *Shiotsu*, however, does not suggest that the transmission power levels would work in an authentication method for managing user terminals and their accounts, and in particular **not** "to increase efficiency of managing the network bandwidth and selecting a more efficient transmission rate," as asserted in the pending Office Action at page 4, lines 1-2.

In addition, *Ito* is not concerned with titles of available application programs and transmission power levels. Instead, *Ito* is concerned with user authentication and access account management. The titles of available application programs, types of information processing devices, and transmission power,⁵ are irrelevant for *Ito*'s authentication. *Ito* states that its structure already achieves the goal of allowing the user to collectively know the actual accounts for the servers connected to the network.⁶ *Ito* does not suggest that further improvement is desired, nor that another feature should be added to further improve the efficiency of managing the network bandwidth and selecting a more efficient transmission rate.

³ *Shiotsu* in the Abstract and at column 3, lines 36-42.

⁴ *Shiotsu* at column 3, lines 31-42.

⁵ *Shiotsu* at column 3, lines 20-25.

⁶ *Ito*, for example, at column 6, lines 54-59.

Ito and *Shiotsu*, therefore, do not provide the motivation to perform the proposed modification of *Ito*. In other words, an attempt to bring in the isolated teaching of *Shiotsu*'s setting of a transmission power level into *Ito* would amount to improperly picking and choosing features from different references without regard to the teachings of the references as a whole. While the required evidence of motivation to combine need not come from the applied references themselves, the evidence must come from ***somewhere within the record***. In this case, the record fails to support the proposed modification of *Ito*. There is no evidence that a person of ordinary skill in the art would be motivated to perform such changes and redesign. Without such motivation and absent improper hindsight reconstruction, a person of ordinary skill in the art would not be motivated to perform the proposed modification, and Claims 1-12 and 19 are believed to be non-obvious and patentable over the applied references for at least this reason.

Independent Claims 2-3, 6, 9-10 and 19, recite features similar or somewhat similar to the features recited in independent Claim 1. Accordingly, for the reasons stated above for the patentability of Claim 1, Applicants respectfully submit that the rejections of Claims 2-3, 6, 9-10 and 19, and the rejection of all associated dependent claims, are also believed to be overcome.

As it is believed that all of the rejections set forth in the Official Action have been fully met, favorable reconsideration and allowance are earnestly solicited. If, however, for any reason the Examiner does not believe that such action can be taken at this time, it is respectfully requested that he telephone Applicants' representative at (908) 654-5000 in order to overcome any additional objections which he might have.

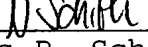
Application No.: 10/079,708

Docket No.: SCEI 3.0-122

If there are any additional charges in connection with this requested amendment, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

Dated: May 18, 2007

Respectfully submitted,

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